



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,417	07/27/2006	Gerhard Genter	3704	8342
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743				
EXAMINER				
YOUNG, EDWIN				
ART UNIT		PAPER NUMBER		
3681				
MAIL DATE		DELIVERY MODE		
04/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,417

Applicant(s)

GENTER ET AL.

Examiner

EDWIN A. YOUNG

Art Unit

3681

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 7/27/2006

DETAILED ACTION

This is the first action on the merits for application 10/587,417. Claims 1-12 are currently pending in this application.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/EP05/50446, filed on 2/20/2005.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 7/27/2006 has been considered by the examiner.

The listing of references in the specification, EP 0981696 B1, is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

Art Unit: 3681

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The disclosure is objected to because of the following informalities: numerous references to specific claims are made, i.e. page 1, line 6. All references to specific claims should be removed, since claim numbering and scope are subject to change throughout prosecution.

Appropriate correction is required.

Claim Objections

Claim 8 is objected to because of the following informalities: line 4, "the eccentric gearing (30)" should be changed to - the eccentric gear (30)-, since the eccentric gear corresponds to element (30). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear what is meant by the phrase "it includes" in line 4. Specifically, it is unclear what "it" refers to.

Regarding claim 2, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 3 recites the limitation "the recesses" in line 5. There is insufficient antecedent basis for this limitation in the claim. It appears that claim 3 should claim dependency from claim 2, which claims recesses.

Regarding claim 5, it is unclear what is meant by the limitation "jacket-shaped surface" appearing in line 4. It is unclear what shape corresponds to a "jacket".

Claim 5 recites the limitations "the body" and "the cover" in line 5. There is insufficient antecedent basis for this limitation in the claim. It appears that claim 5 should claim dependency from claim 4, which claims a body and a cover.

Claim 7 recites the limitation "the first line" in line 6. There is insufficient antecedent basis for this limitation in the claim. It appears that claim 7 should claim dependency from claim 6, which claims "two lines".

Claim 8 recites the limitation "the second line" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim. It appears that claim 8 should claim

Art Unit: 3681

dependency from claim 7 (assuming claim 7 is dependent from claim 6), which claims "the first line".

Regarding claim 9, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 11, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 12 recites the limitation "the cover" in line 4. There is insufficient antecedent basis for this limitation in the claim. It appears that claim 12 should claim dependency from claim 4, which claims "a cover".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 8, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by MOSKOB (US 6,280,359).

Regarding claim 1 as best understood, MOSKOB discloses eccentric gearing (see Figs. 3 and 4) for displacing two parts positioned in a manner that enables them to move relative to one another, which includes a gearing housing (see elements (2 and 5) in Fig. 1), an eccentric element (8), which is driven by a rotary drive (see element (4) in

Fig. 1) and on which an eccentric gear (10) is rotationally mounted, and it includes an output element (15), which interacts with the eccentric gear by meshing therewith in sections, wherein the eccentric gear is actively connected to a coupling element (20) placed inside a recess (23) of a fastening flange (6) that enables the eccentric gearing to be fixed on one of the two parts.

Regarding claim 5 as best understood, MOSKOB discloses the fastening flange (6) including at least one cylindrical jacket-shaped surface (location where element (6) abuts element (5)), against which a body (2) and/or a cover (5) bear radially.

Regarding claim 6 as best understood, MOSKOB discloses the coupling element (20) including guide elements (21, 22) that interact with corresponding counter-elements to force the eccentric gear into superimposed movement along two lines (Fig. 4) positioned nearly perpendicularly to each other, and to prevent the eccentric gear from rotating (see column 3, lines 37-45).

Regarding claim 8 as best understood, MOSKOB discloses the eccentric gear (10) including axial guide bolts (18, 19) that engage in second radial recesses (21, 22) of the coupling element (20) to guide the motion of the eccentric gear relative to the coupling element along a second line (Fig. 4).

Regarding claim 9 as best understood, MOSKOB discloses when torque acts via the output element (15) on the coupling element (20), the coupling element bears directly against fastening flange (6) via support shoulders (Fig. 4).

Regarding claim 11 as best understood, MOSKOB discloses the eccentric element (8) being fastened to a support bolt (1) supported in the gearing housing and being driven.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over MOSKOB (US 6,280,359) in view of BRANOV et al. (US 2004/0014545 A1).

Regarding claim 2 as best understood, MOSKOB discloses the eccentric gearing of claim 1, described in detail above, but does not disclose the fastening flange including recesses for connecting elements which interact with one or both parts and/or with the gearing housing.

BRANOV et al. discloses eccentric gearing for a vehicle seat adjuster (see Fig. 1) wherein a fastening flange (16) includes recesses for connecting elements, which interact with one or both parts of a vehicle seat (see paragraph [00018]).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the fastening flange of MOSKOB with recesses for connecting elements, which interact with one or both parts, in light of the teachings of BRANOV et al., in order to allow the eccentric gearing to be utilized as a vehicle seat adjuster.

Regarding claim 3 as best understood, BRANOV et al. discloses regions which extend beyond the gearing housing (indicated by the circular region (14)), and in which recesses are located. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the fastening flange out of metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 12 as best understood, MOSKOB, as modified by BRANOV et al., discloses the output element (15) being supported in a cover (5) of the gearing housing and displacing a seat part in the motor vehicle using a form-fit interface (see Fig. 1 of BRANOV et al.).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over MOSKOB (US 6,280,359).

Regarding claim 4, MOSKOB discloses the claimed invention including the gearing housing including a body (2) and a cover (5), each of which is fastened to an axial side (left-hand side of Fig. 3) of the fastening flange (6), but does not disclose the body being made of plastic.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the body out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claims 7 and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWIN A. YOUNG whose telephone number is (571)272-4781. The examiner can normally be reached on M-TH 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. A. Y./
Examiner, Art Unit 3681

/Sherry L. Estremsky/
Primary Examiner, Art Unit 3681